Remarks:

Claims 1-14 are pending in the present application.

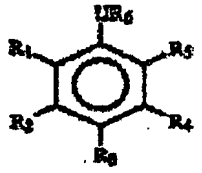
Allowable Subject Matter:

Applicant thanks the Examiner for the indication that claims 2 and 9-14 have been contain allowable subject matter.

Regarding the rejection of claim 1, 3, 4 and 6-8 under 35 USC 103(a) as being unpatentable over US 5387718 to Köhler et al. (Köhler):

Applicant respectfully traverses the rejection of the foregoing claims in view *of* Köhler.

The Patent Office alleges that Köhler discloses all the features of claims 1 and 8 because Köhler discloses alkylphenyl alkyl thioethers having the general formula:



where U represents O or S; and
R_1–R_6 each independently represent an alkyl or aryl group, but R_1–R_5 may each independently represent a functional group other than these, including, e.g., but not limited to, —COOR, —NO_2, —NH_2, —O—CH_2—CH_2—OH, —OH, —CHO, or -halogen; further
R_1–R_5 may be bridged by suitable bifunctional substituents, such as, e.g., —$(CH_2)_x$—, or —$(CH_2)_x$—Z—$(CH_2)_y$— (where Z represents a hetero atom; x=0-7, and y=0-7), or preferably unsaturated substituents such as are characteristic of anellated ring systems, e.g. (but not limited to) naphthyl, phenanthryl, anthracenyl, quinolyl, isoquinolyl, or indolyl. (1:15-42); wherein U=S, R_6=Me, R_3=alkyl having a fused C_{0-7} cycloalkyl ring R_1=R_2=R_4=R_5=H (2:60-67; 3:6-12; 4:48-46; 6:50-59).

The Patent Office acknowledges that Köhler does not positively state all the claimed effects or physical properties of the present invention of claim 1 (see page 3 of Köhler). The Patent Office alleges that because Köhler teaches all of the claimed reagents, the claimed effects and physical properties, i.e. spicy and anisic odor notes, would implicitly be achieved by a composition with all the claimed ingredients. Present claim 8 was rejected on the same or similar grounds as claim 1 set forth above. Applicant respectfully disagrees with the allegations of the Patent Office.

Prior to discussing the merits of the Patent Office's position, the undersigned reminds the Patent Office that the determination of obviousness under § 103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. *McNeil-PPC, Inc. v. L. Perrigo Co.*, 337 F.3d 1362, 1368, 67 USPQ2d 1649, 1653 (Fed. Cir. 2003). See also *KSR International Co. v. Teleflex Inc.*, 82 USPQ2D 1385 (U.S. 2007).

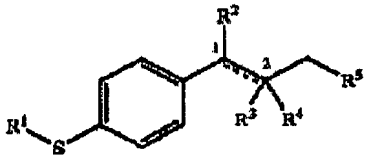
A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016,

1022 (Fed. Cir. 1991); In re O'Farrell, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton,* 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.,* 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Köhler does not teach or suggest a flavour or fragrance compound according to formula I (claim 1) and a compound of formula I (claim 8)

I



wherein

i) the bond between C_1 and C_2 is a single bond;

R^1 is methyl, ethyl, i-propyl, n-propyl;

R^2 and R^3 are independently hydrogen or methyl; or

R^2 and R^3 taken together is a divalent radical $(CH_2)_n$, $C(CH_3)_2$, or $CH(CH_3)$ which forms a cycloalkane ring together with the carbon atoms to which it is attached;

R^4 and R^5 are independently hydrogen or methyl; or

R^4 and R^5 taken together is a divalent radical $(CH_2)_n$, $(CH_2)_{n-1}CH(CH_3)_2$, or $(CH_2)_{n-1}CH(CH_3)$ which forms a cycloalkane ring together with the carbon atoms to which it is attached;

n is an integer of 1, 2, 3, or 4; and

wherein at least one cycloalkane ring is present; or

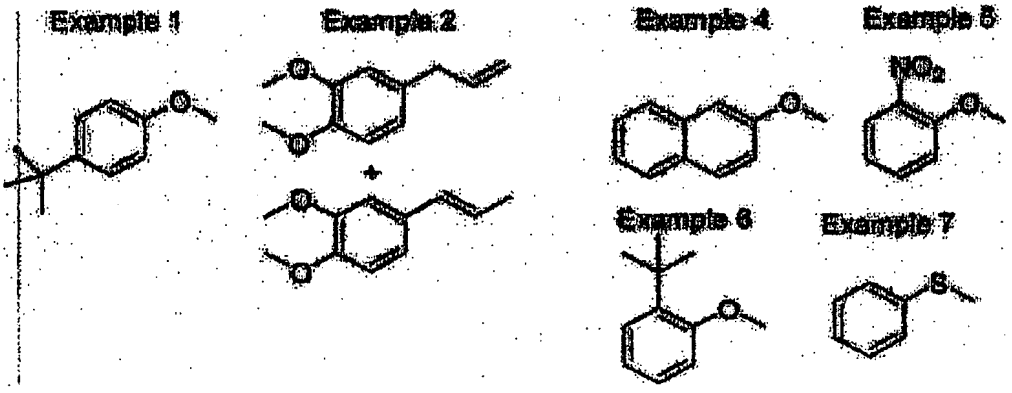
as required by independent claims 1 and 8, respectively.

In contrast, that Köhler teaches a method-of manufacturing alkylphenyl alkyl ethers and thioethers of the general formula

i.e. a class of compounds having in common a phenol /thiophenol-ring. The phenol/thiophenol-ring being substituted at each carbon atom. The substituents according to Köhler are very broadly defined by using even more variables, such as Z, y and x.

Applicant submits that the selection of the residues as alleged by the Patent Office is arbitrary and clearly based on the hindsight knowledge of the present application, which is improper and not allowable during assessments for obviousness.

All the examples (Examples 1, 2 and 4-7) given in Köhler are compounds quite remote from the class of compounds recited in claims 1 and 8. The compound of Example 1 is p-tert-butylphenyl methyl ether; the compounds of Example 2 are eugenol methyl ether and isoeugenol methyl ether; the compound of Example 4 is β-naphthyl methyl ether; the compound of Example 5 is 2-Nitroanisole; the compound of Example 6 is o-tert-butylphenyl ethyl ether; and the compound of Example 7 is thioanisole. The structures for the compounds of each example are as follows:



It is clear that the compounds of the Examples 1, 2 and 4-7 of Köhler and the compounds taught in accordance with Köhler are not structurally the same as or similar to the class of compounds of the present claims and thus do not teach or suggest the class of compounds required by the present claims.

Thus, it is Applicants' viewpoint that only by "hindsight reconstruction" has the Patent Office selected among the various teachings of Köhler and the present application in order to reconstruct the flavour or fragrance compound or the compound as required in claims 1 and 8, respectively. However, as is well-recognized in the jurisprudence such a hindsight reconstruction is impermissible. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (CAFC, 1983); *In re Mercier* 185 USPQ 774, 778 (CCPA, 1975); *In re Geiger* 2 USPQ2d 1276 (CAFC, 1987).

Additionally, contrary to the allegations by the Patent Office on page 3 of the Office Action, Köhler does not teach or suggest all the reagents recited in the present claims. Additionally, Applicant submits that if such teachings of all the reagents of the present invention is present in Köhler, such teachings or disclosure of all the reagents should be point out by the Patent Office in the Office Action. Applicant further submits that such a disclosure regarding the claimed reagents does not exist in Köhler because the Patent Office fails to identify where such disclosure(s) is located within Köhler. Instead, the Patent Office alleges that if it is Applicant's position that this is not the case, it is the Patent Office position that the application contains inadequate disclosure. Applicant respectfully traverses these allegations.

By carefully defining the claimed class of compounds of formula (I) as recited in claims 1 and 8 in combination with Examples 1-6 of the present application, Applicant has sufficiently illustrated, to one of ordinary skill in the art, how to obtain the claimed properties and effects, namely by using a compound of formula (I) as defined in claims 1 and 8.

Moreover, Applicant submits that Köhler fails to teach or suggest which sub-class of compounds might be suitable as intermediate products, or which might be suitable as drugs. Even a person not skilled in the art may acknowledge that a compound suitable for plant protection is not necessarily inherently suitable as drug or fragrance. At best, Köhler teaches, that "the products synthesized according to the method are important intermediate products, or may themselves be used as fragrances, drugs, plant protection agents, or stabilizers for oils used in food and feed" (see col. 5, lines 42-45 of Köhler).

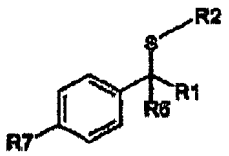
In view of the foregoing remarks, Applicant disagrees with the Patent Office's position, traverses the Patent Office's rejection and asserts that the Patent Office has not met the proper burden of proof to present and maintain the rejection; such are simply unsupported by the facts for the reasons noted above. Rather, Applicant contends that the Patent Office's grounds of rejection is at, at best, a hindsight reconstruction, using Applicants' claims as a template to reconstruct the invention by picking and choosing amongst isolated disclosures from the present application and Köhler. This is impermissible under the law. Accordingly, reconsideration of the propriety of the rejection of claims 1, 3, 4, 6 and 7 and its withdrawal is respectfully requested.

Regarding the rejection of claim 5 under 35 USC 103(a) as being unpatentable over Köhler in view of EP 1264547 to Grab et al. (hereinafter "Grab"):
Applicant respectfully traverses the rejection of the foregoing claim in view of Köhler and Grab.

The Patent Office acknowledges that Köhler fails to teach a household product containing alkylphenyl alkyl thioethers (see page 5 of the Office Action). The Patent Office introduces Grab as allegedly teaching the deficiencies of Köhler. The Patent Office alleges that it would have been obvious to have combined Grab and Köhler and that Grab discloses motivation to combine Grab with Köhler to achieve the present invention as alleged by the Patent Office.

Grab does not remedy the deficiencies of Köhler as described above with respect to independent claim 1, from which claim 5 indirectly depends. Specifically, Grab fails to teach or suggest that the specific features of formula (I) as required by claims 1. Instead, Grab, at best, teaches or suggests:

[0006] Accordingly, the invention provides in one of its aspects a flavour or fragrance composition comprising a compound of formula (I)



wherein R1 represents an alkyl group having from 1 to 4 carbon atoms which may be branched or unbranched; R2 represents, hydrogen; acyl, in particular selected from the group -(R3)C=O wherein R3 represents a branched or unbranched alkyl group having from 1 to 4 carbon atoms ; or an alkoxyalkyl group, in particular selected from the group -CH(R4)-OR5, wherein R4 represents hydrogen or a branched or unbranched alkyl group having from 1 to 4 carbon atoms; R5 represents a branched or unbranched alkyl group having from 1 to 4 carbon atoms; R6 represents hydrogen or methyl; and R7 represents hydrogen, methyl or alkoxy having 1 to 4 carbon atoms, e.g. methoxy.

[0007] R1, R3, R4 and R5 independently are particularly represented by methyl, ethyl, n-, or iso-propyl, and n-, or iso-butyl. R2 is particularly represented by hydrogen, formyl, acetyl, propionyl, butyryl, isobutyryl, 1'-ethoxyethyl, 1-methoxyethyl, or 2'(2'-methoxypropyl).

(see paragraphs [0006] and [0007] of Grab).

Because the features of independent claim 1, from which claim 5 indirectly depends, are not taught or suggested by Köhler and Grab, taken singly or in combination, these references would not have rendered the features of claim 5 obvious to one of ordinary skill in the art.

In view of the foregoing, reconsideration and withdrawal of this rejection are respectfully requested.

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application,

they are invited to call the undersigned at their earliest convenience. The early issuance of a *Notice of Allowability* is solicited.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;

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26 Sept 2008
Date:

CERTIFICATION OF TELEFAX TRANSMISSION:

I hereby certify that this paper and any indicated enclosures thereto is being telefax transmitted to the US Patent and Trademark Office to telefax number: 571-273-8300 on the date shown below:

Allyson Ross

Sept 26 2008
Date

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